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Eing. 01. Juni 2004

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Application No. 02 023 437.3 - 2108	Ref. 2001US406	Date 28.05.2004
Applicant CLARIANT INTERNATIONAL LTD.		

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 7B(2) and 83(2) and (4) EPC.

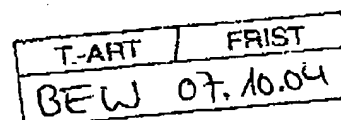
One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



VAYSSIE S F P
Primary Examiner
for the Examining Division

Enclosure(s): 4 pages reasons (Form 2906)
D20



Registered Letter
EPO Form 2901 07.02.03X



Beschold/Protokoll (Antage)

Communication/Minutes (Annex)

Notification/Procès-verbal (Annexe)

Datum
Date

28.05.2004

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Anmelde-Nr.:

Application No.: 02 023 437.3

Demande n°:

The examination is being carried out on the following application documents:

Text for the Contracting States:

DE FR GB IT

Description, pages:

1-15 as originally filed

Claims, No.:

1-10 as received on 27.04.2004 with letter of 28.04.2004

Note on the admissibility of the amendments

Amendments to the present application, as received on 27.04.04, fulfill the requirements of Article 123(2) EPC and are therefore admissible.

1. The following new document is cited by the examiner (see the Guidelines, C-VI, 8.9). A copy of the document is annexed to the communication:

D20: US 6143309 B.

The numbering will be adhered to in the rest of the procedure.

2.a Claims 1-10: Objections under Article 54 EPC

While the applicant's observations submitted with the amended claims have been considered, the previously expressed patentability objections are nevertheless maintained for the following reasons:

- D20: ex. 6, with c = caprylyl trimethicone, a = dimethiconol, b = fragrance, parath-15, triglycerides...

2.b Objections under Article 82 and 56 EPC



Bescheld/Protokoll (Anlage)

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The application lacks unity *a posteriori* within the meaning of Article 82 EPC for the following reasons:

Grounds for objection:

The invention is characterized by compound "a". As a), a choice has to be made within a list of 8 compounds. This results in 8 inventions.

The common concept linking together these inventions (Article 82 EPC) is the following:

- homogeneous mixture comprising
 - a silicone oil a)
 - an organic oil b)
 - an organomodified silicone c) of formula 2) with the claimed values for R and y.

Lack of novelty of the general concept:

This single general inventive concept is known in the art, see 2.a.

Note: still, as stated by Decision W 6/90 (§ 3.2), the most reliable indication of lack of unity in the present case lies in the fact that at least one of the alternative embodiments of the invention lacks novelty (and this applies of course still more to their common concept), see D20.

Lack of inventive step of the general concept:

Since inventive step objections according to the problem-solution approach require the existence of at least one feature distinguishing the common concept from the prior art, a proper inventive step objection is only possible if the common concept is novel. However, the following can already be stated.

The technical problem solved by the invention was thus to provide a composition with improved homogeneity properties (see application, page 2, lines 2-3).

However, the subject-matter of the invention according to Claim 1 or 9 would only differ from



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Notification/Procès-verbal (Annexe)

Annexe-Nr.:
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the state of the art D20 in the substitution of the silicone oil of the prior art (dimethiconol, D20) by alternative ones (PDMS, PDES, cyclomethicones...).

Such a substitution is a common operation in the art, is therefore within reach of a skilled person without any inventive step and can only be considered as inventive if it produces an unexpected effect or presents an unexpected property with respect to:

- the specific compounds disclosed in the cited art, and
- the rest of the range of the analogues.

However, no such effect or property is indicated in the application, and this applies to all of the different silicone oils.

Therefore, not only the claimed subject-matter does not involve an inventive step as required by Article 56 EPC, but also - logical consequence - the general concept (which is larger than the claimed subject-matter) does not involve an inventive step either, further resulting in a lack of unity under Article 82 EPC.

Legal consequences:

The general concept is neither novel, nor does it involve an inventive step. Thus, a technical relationship involving one or more of the same or corresponding special technical features in the sense of Rule 30 EPC does not exist between these inventions. Unity of invention must therefore be denied.

Since it is not clear on which invention or group of inventions the further prosecution of the application should be based, no further prosecution can be carried out. The applicant is asked to state upon which invention or group of inventions further prosecution of the application should be based and to limit the application accordingly. The other invention or group of inventions is to be excised from the claims, description and drawings if any.

The subject-matter to be excised may be made the subject of one or more divisional applications. The divisional applications must be filed directly at the European Patent Office in Munich or its branch at The Hague and in the language of the proceedings relating to the present application, cf. Article 76(1) and Rule 4 EPC. The time limit for filing divisional applications (Rule 25(1) EPC) must be observed.



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3. The Applicant is requested to file new claims which take account of the above comments.

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